



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,559	08/03/2001	Jon E. Beck	IOM-P022.01	1726

22876 7590 02/04/2003

FACTOR & PARTNERS, LLC
1327 W. WASHINGTON BLVD.
SUITE 5G/H
CHICAGO, IL 60607

EXAMINER

SIRMONS, KEVIN C

ART UNIT PAPER NUMBER

3763

DATE MAILED: 02/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/922,559

Applicant(s)

BECK ET AL.

Examiner

Kevin C. Sirmons

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 3763

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: It is unclear what applicant regards as the means 24 for flexing the handle member, means 26 for limiting the flexing member of the handle member and means 25 for maintaining registered placement of the apparatus. Clearly give a specific example and define each of the above means.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7, 8, 9, 16, 17, 18, 26, 27 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites the limitation "the lateral angle." There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "the region." There is insufficient antecedent basis for this limitation in the claim.

As to claim 7, it is unclear what applicant is attempting to claim. It is further unclear what is meant by the region encompassed by the lateral angle.

Claim 8 recites the limitation "the medial angle." There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 3763

Claim 8 recites the limitation "the region." There is insufficient antecedent basis for this limitation in the claim.

As to claim 8, it is unclear what applicant is attempting to claim. It is further unclear what is meant by the region encompassed by the medial angle.

Claims 6, 15 and 26 recite the limitation "the biasing." There is insufficient antecedent basis for this limitation in the claim.

Claims 16 and 27 recite the limitation "the lateral angle." There is insufficient antecedent basis for this limitation in the claim.

Claims 16 and 27 recite the limitation "the region." There is insufficient antecedent basis for this limitation in the claim.

As to claims 16 and 27, it is unclear what applicant is attempting to claim. It is further unclear what is meant by the region encompassed by the lateral angle.

Claims 17 and 28 recite the limitation "the medial angle." There is insufficient antecedent basis for this limitation in the claim.

Claims 17 and 28 recite the limitation "the region." There is insufficient antecedent basis for this limitation in the claim.

As to claims 17 and 28, it is unclear what applicant is attempting to claim. It is further unclear what is meant by the region encompassed by the medial angle.

As to claims 9, 18 and 29, it is unclear what applicant regards as the means for biasing.

Art Unit: 3763

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Bosniak et al U.S. Pat. No. 5,169,384.

Bosniak discloses an iontophoretic apparatus comprising: a housing member (20); a current distribution member (50) associated with the housing member; a medicament containment member (54) associated with the current distribution member; a handle member (32) associated with the housing member, the handle member including: a lateral straddling member (32A); a medial straddling member (32B); (note: Applicant merely has several reference numerals such as (20, 25, 46, 72 etc.) all indicating the same part, which is the handle member (18). Applicant has not placed any structural limitations in the claims that would differentiate his device over the prior art of record.); and wherein the cooperation of the straddling members cooperates with the soft tissue of the eye to retain the apparatus in a desired orientation (fig. 1); as to claim 2, (32A and 32B see above note indicating several reference numerals indicating the same part); as to claim 3, at least one of the first and second handle regions (32A, 32B) including a gripping region (not numbered; however, clearly seen in fig. 1), the gripping region facilitating the grasping of the handle region by a user (col. 6, lines 18-23); as to claim 4, (fig. 1); as to claim 5, (the straddling members (32A, 32B) can be adjusted so that they facilitate retention of an eyelid); as to claims 6-9, (fig. 1); and as to claims 10-29, (see above rejection).

Art Unit: 3763

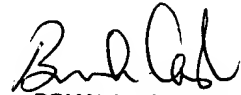
Conclusion

Note: The claims are replete with vague and indefinite language. Upon correction of the 112 rejections, the claims may be rejected under 102, 103 or other 112 rejections and the case made final.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kevin C. Sirmons whose telephone number is (703) 306-5410. The examiner can normally be reached on Monday - Thursday from 6:30 am to 4:00 pm. The examiner can also be reached on alternate Fridays.



Kevin C. Sirmons
Patent Examiner
1/30/03



BRIAN L. CASLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700